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EXAMINER	
CADUGAN, ERICA E	

ART UNIT	PAPER NUMBER
3726	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/556,660	GYSI ET AL.	
	Examiner	Art Unit	
	Erica E. Cadugan	3726	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 August 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 17-19* is/are pending in the application.

4a) Of the above claim(s) *1,6-8,10-12 and 19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-5,9,13-15,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *19 August 2009* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/11/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. In the response of August 19, 2009, Applicant indicated the following:

> In response to the Restriction Requirement of July 16, 2009, Applicant hereby elects to pursue in this application the species of Fig. 14. Claims readable on the species are 2-9, 13-15, 17 and 18. Additionally, Applicant also hereby elects to pursue the sub-species defined in Claim 13. Claims readable on the sub- species are also 2-9, 13-15, 17 and 18.

Since the species of Figure 14 was not one of the choices indicated in the restriction requirement of July 16, 2009, and since the "sub-species defined in Claim 13" likewise was not one of the sub-species choices and did not address whether Applicant was electing a sub-species wherein the sealing processing station is a combined processing station which stamps a tear-off cover from a foil and places it over the hole (as per claim 5, for example), or a different sub-species wherein the sealing processing station is one equipped to apply a previously stamped out tear-off cover (as per claim 6, for example), the election submitted August 19, 2009 did not serve to overcome the issues set forth in the Notice of Non-Compliant Amendment mailed July 16, 2009.

Examiner, on November 17, 2009, contacted Applicant's representative, Mr. John Linderman, to determine what species was/were intended to be elected so that an accurate determination of which claims are readable on the elected species could be made.

See the Interview Summary, mailed November 19, 2009, for a more detailed description of the interview.

Mr. Linderman indicated that Applicant wanted to elect an embodiment like that of Figure 14 with a single row, instead of the embodiments of Figures 11 and 12 which each, in different ways, have multiple rows of tooling.

Examiner notes the paragraph 0027 of the specification teaches that "[F]ig. 14 shows in three-dimensional representation a part of a processing device according to the invention wherein this is implements as a single row processing device, in which therefore in each of the processing stations only a single work tool and not a group of work tools work on the object", and also teaches (in paragraph 0027) that [A] preceding and succeeding processing stations are not illustrated in this figure, but correspondingly are constructed as processing stations for a single object".

Additionally, Mr. Linderman indicated that Applicant wanted to elect the sub-variant shown in new Figure 15 wherein the sealing station 47 is a combined processing station which stamps a tear-off cover 25 from a foil and places it over the hole, as opposed to the arrangement shown in Figure 10, for example, wherein a processing station 45 including a stack 41 of precut foils is provided.

That said, Examiner notes that the response of August 19, 2009 indicated that the claims readable on the elected embodiment(s) are 2-9, 13-15, 17, and 18. However, it is noted that claim 6 (and claims 7-8 that depend therefrom) are directed to an embodiment wherein the sealing processing station "is one equipped to apply a previously stamped out tear-off cover", rather than the sub-variant indicated by Mr. Linderman wherein the sealing processing station is a "combined processing station which stamps a tear-off cover from a foil and places it over the hole".

Thus, claims 6-8, in addition to the claims 1, 10-12, and 19 are withdrawn from consideration as being drawn to non-elected species. Claims 1, 6-8, 10-12, and 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species,

there being no allowable generic or linking claim. Election was made in the reply filed on August 19, 2009 in combination with the interview of November 17, 2009. Because applicant did not distinctly and specifically point out any supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Drawings

Response to Amendment

2. The replacement sheets of drawings, as well as the new sheet of drawings (that shows new Figures 15 and 16) are approved.

Particularly, it is noted that new Figure 15 is approved, noting that the addition to the brief description of drawings indicates that Figure 15 is a "schematic" side view, and that paragraph 0017 as originally filed supported a substitution in the embodiment of Figure 10 of a foil stamping work stool that stamps the foil directly from a large foil web and adheres it to the cover part for the processing station shown in Figure 10 wherein precut cover foils were arranged in the stack at 45, which is what is shown in Figure 15 (i.e., Figure 10, but with a stamping station schematically shown in place of the stack).

Likewise, the amendment to the brief description of Figure 16 likewise indicates that new Figure 16 is a "schematic representation" (as was Figure 10), and thus, the relative spacing of the stations, etc., is considered only for schematic purposes and is not considered to be an actual representation of the distance between the stations, nor an actual depiction of the tooling, etc., . Additionally, it is noted that paragraph 0019 of the specification as originally filed teaches that "[O]bviously, in known ways, the stations 45 and 46 can be omitted and the stamping out of the foil 25, its placement on the cover opening, and its fastening can all take place in the station 47",

and that Figure 16 is merely a schematic representation of Figure 10, but with the stations 45 and 46 removed, as taught by paragraph 0019.

Double Patenting

3. Applicant is advised that should claim 3 be found allowable, claim 17 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-5, 9, 13-15, 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 2, last line, it appears that language such as --at a time-- or --at one time-- should be inserted after "the processing of a single object" for accuracy and clarity, noting that the stations are each equipped for performing processing on multiple objects in succession, i.e., one, and then another, then another, etc.

There are several positively recited limitations that lack sufficient antecedent bases in the claims. Examples of this are: "the advancement direction" in claim 2, lines 2-3 and in claim 18, line 3; "the advancing device" in claim 2, line 3 and in claim 18, line 3(previously claimed was an "advancing mechanism"); "the tear-off foil" in claim 9, line 3; "the hole" (and "the edge" of

such hole) in claim 9. This is not meant to be an all-inclusive list of such occurrences. Applicant is required to review the claims and correct any other such occurrences of limitations lacking sufficient antecedent basis.

In claim 3, line 2, it is unclear as claimed to what "it" refers.

In claim 4, line 4, it is unclear, via the use of the indefinite article "a", whether "a tear-off cover" is intended to be different from, or a subset of, the "tear-off foils" previously set forth in claim 3.

In claim 5, line 3, it is unclear whether "a tear-off cover" is intended to be different from the "tear-off foil" previously set forth in the claims (additionally noting that claim 3 describes "metal covers with tear-off foils", as opposed to any "tear-off cover").

In claim 5, line 3, Examiner suggests changing "it" to --the stamped tear-off cover" (or similar language, depending on how the "cover" vs. "foil" language is presented in the future.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*,

86 USPQ 481 (Bd. App. 1949). In the present instance, claim 9 recites the broad recitation "a coiling station… and a bending station", and the claim also recites "especially a combined coining and bending station" which is the narrower statement of the range/limitation. It is further unclear, if the one of the processing stations has both a "coining station" and a "bending station" as defined by claim 9, in what way such would be different from a "combined" coining and bending station as further set forth in claim 9, noting that it would appear that saying one station has both coining and bending stations would mean that they are "combined" in the one station.

In claim 13, there is no frame of reference provided for determining what constitutes a "subsequent" station, i.e., subsequent to which station? A similar situation exists in claim 18, line 7.

In claim 14, line 2, it is unclear as claimed to what "it" refers.

In claim 14, it is unclear as set forth in the claim whether the claimed "processing stations" are a subset of the processing stations previously set forth in claim 2. If so, Examiner suggests utilizing language such as "wherein at least one of the processing station is a stamping processing station" and "one of the processing stations is a sealing processing station" for clarity.

In claim 17, line 2, it is unclear as claimed to what "it" refers.

In claim 18, lines 1-2 set forth an "advancing mechanism", line 3 sets forth "the advancing device", and at least line 6 sets forth "an advancing arrangement". It is unclear as set forth in the claim if these limitations are all intended to refer to the same disclosed structure. If so, Examiner suggests being consistent with the use of one of the terms throughout the claim for clarity.

In claim 18, fifth line from the end, Examiner suggests deleting "each" for accuracy and clarity, as it does not appear that each individual station, i.e., by itself, is designed to produce a whole metal cover with a tear-off foil, and it is unclear via the "each" term whether this is what is intended to be claimed.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2, 13, and 15, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,112,389 to Boltshauser.

Boltshauser teaches a processing device including an "advancing mechanism" that includes at least belts 8 and 5 (see Figure 5) that advance a "single row succession of objects" in the form of cans 3 in an "advancement direction" (i.e., along the path followed by the cans as they are advanced by the conveyor belt 8, then along the path they are sent by element 10, and again toward the right as they are advanced by the conveyor belt 5 (see at least Figure 5 and col. 9, lines 9-34, for example). Note that the processing stations 1 and 4 are "each equipped for the processing of a single object", since, as shown in Figure 5, that is what the stations 1 and 4 are processing.

Regarding claim 13, as broadly set forth in the claim, the "advancing arrangement" taught by Boltshauser is comprises of two conveyor belts 5, 8 that are arranged parallel to one

another (as shown in Figure 5). These belts are considered to be driven in synchronism, at least in that they must be "synchronized" to operate at the same time in order for the arrangement to operate as intended, i.e., if belt 8 was operated and belt 5 was not, then cans 3 would back up and eventually fall on the floor; see Figure 5.

Additionally regarding claims 13 and 15, note that "individual object receivers" that are "formed by opposed holding means" are arranged on the conveyor belts 5, 8, noting that each conveyor belt 5, 8 includes "object receivers" thereon that include magnetic pallets 7 that each receive one of the objects 3 and that also include magnets 6 located "on" the lower side of the belts that "oppose" the magnetic pallets 7 to help hold the pallets, and thus the objects 3 affixed thereto, to the respective conveyor(see Figure 5, see also at least col. 9, lines 9-34, for example).

8. Claims 2 and 13, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,122,821 to Dornieden et al.

Dornieden et al. teaches a processing device including a number of processing stations 2 that are arranged in succession along an advancement direction D (see Figure 1), wherein an "advancing mechanism" 4 is provided for advancing a "single row succession" of objects (such as workpieces 6; see Figures 2 and 4, noting that Figure 4 is a sectional view taken along line IV-IV of Figure 2) to the processing stations 2, which are thus considered to be "equipped for" processing the single object advanced thereto.

Regarding claim 13, note that the advancing arrangement includes two parallel conveyor belts 14 (see Figures 3 and 4, also see col. 3, line 66 through col. 4, line 6, for example), which

belts are driven in "synchronism" via motor 8, belt 38, and pulley 28 (see Figures 1 and 3, see also col. 3, line 66 through col. 4, line 2).

Note that on the conveyor belts 14, the individual object receivers 5 include, and are thus at least in some sense "formed by", "opposed" holding means, such as two of the teeth 15 that are on opposite ends of 5 which "hold" the holder 5 on the belt 14 (see Figure 2a), or alternatively, such as the guide shoe 24 which helps "hold" the receiver 5 on the rail 24, and which is on an opposite side of the receiver (and is thus "opposed" to 37) from metallic insert 37 that has a seat that can fit the end of a retaining element 26 of a retaining mechanism 25 to "hold" the receiver 5 in a station 2 (see col. 4, lines 40-53 and Figure 4).

9. Claims 2-5, 9, and 17, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 USC 102(a) as being anticipated by Applicant's Admitted Prior Art (hereinafter AAPA) shown in Figures 1 and 2 (both labeled as "Prior Art"), as well as in paragraph 0014 of the specification as originally filed.

AAPA teaches a processing device (shown in Figure 1) that includes an "advancing mechanism" 10, 13, 14 that advances objects in the advancement direction C (see Figure 1 and paragraph 0014), wherein a plurality of processing stations (any ones of 3-9, for example, see Figure 1 and paragraph 0014) are arranged in succession along the advancement direction C.

It is noted that, as broadly claimed, the processing stations are each "equipped for" performing the claimed intended use of the "processing of a single object", merely by only feeding one object to one set of tooling, i.e., just because the admitted prior art in Figure 2 teaches that plural sets of tools 36, 37 are present does not prevent the device from being used where only a single set of the tools are used at a time (by not feeding work to more than one set

of the tools). Similarly, the "advancing device" is considered to be capable of performing the claimed intended use of "advancing a single row succession of objects" by only providing a single row of objects to be advanced thereto.

Regarding claims 3 and 17, note that the arrangement of Figure 1 is described in the first sentence of paragraph 0014 as being "for the production of metal covers with tear away foils", and paragraph 0014 additionally teaches that "[I]n the first processing station 3 of Fig. 1 by a stamping process using upper and lower work tools an opening in stamped in the disk, which is visible in Fig. 4, in which a figure the edge of the opening is indicated at 21 and the stamped out round disk is indicated at 27"

Regarding claim 4, re the claimed "drawing processing station, AAPA additionally teaches (in paragraph 0014) that "[A]t the processing station 14 a drawing of the edge 21 downwardly takes place whereby the development of the edge to that as shown in Fig. 5 takes place".

Also regarding claim 4 and the claimed "sealing processing station for applying a tear-off foil over the hole", AAPA, in paragraph 0014, teaches the following:

> The circularly shaped cover blank 20 moves then to the processing station 5, in which a foil 25 is placed over the opening of the cover 20 and is there fastened to the cover by way of heat sealing, as is to be seen in Figs. 6 and 7. The metal foil 25 is provided in a known way with a plastic film on its underside. The needed round foil blank 25 as a rule is stamped in station 5 from a wide foil web and is placed over the middle aperture of the circularly shaped disk and by way of the heat sealing station the foil under the effect of heat is pressed onto the round aperture of the part 20 so that the foil 25 is connected to the metal cover 20 by the melting and subsequent cooling of the plastic layer. This is known and is not described in further detail here.

Re claim 5, note that the aforedescribed passage from paragraph 0014 regarding the sealing station 5 indicates that the blank is stamped in station 5 from a wide foil web and then sealed over the previously-punched hole in station 5.

Re claim 9, note that AAPA, in paragraph 0014, additionally teaches that "[I]n the processing station 8 the foil 25 is provided with a coining processing , and the edge 22 is further flanged into the finished edge 23", thus teaching that station 8 is a coining and bending (to perform the flanging operation) station.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 13, 14 and 18, any of which were rejected under 35 USC 112 above are as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter AAPA) shown in Figures 1 and 2 (both labeled as "Prior Art"), as well as in paragraph 0014 of the specification as originally filed, and further in view of U.S. Pat. No. 6,122,821 to Dornieden et al.

AAPA teaches all aspects of the presently-claimed invention as set forth above, but does not teach the "two conveyor belts arranged parallel to one another and driven in synchronism, on which conveyor belts individual object receivers are formed by opposed holding means" as set forth in claims 13 and 18.

However, Dornieden teaches such an advancing arrangement, as described in detail in the rejection under 35 USC 102(b) based thereon above. (See previous 102 rejection for details).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted the conveyor-type advancing arrangement that advances work receivers to multiple stations in succession taught by Dornieden for the advancing arrangement 10, 13, 14 taught by AAPA for the purpose of providing an advancing arrangement that is "an extremely simple system which, while ensuring perfectly synchronous movement and exact positioning of the holders as they move through the work stations", that "allows holders to be added to or taken out of the queue upstream of the holding station", and for the purpose of providing a system that is "extremely simple to operate, control, and service and extending the conveyor downstream is a simple matter of adding on another section, with the belts of the new section simply interleaved with the belts of the existing section and spanned over the downstream wheel or roller of the existing section" as taught by Dornieden (col. 2, lines 55-64).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica E. Cadugan whose telephone number is (571) 272-4474. The examiner can normally be reached on Monday-Thursday, 5:30 a.m. to 4:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erica E Cadugan/
Primary Examiner
Art Unit 3726

eec
November 19, 2009